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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/304,121 05/03/99 VOELLMY R 870109.409

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HM22/1126

EXAMINER

SATISH, J

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

11/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/304,121

Applicant(s)

Richard Voellmy

Examiner

Jaya Satish

Group Art Unit

1645-

☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-35 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-35 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1645

## **DETAILED ACTION**

### ***Specifications***

1. Please note that applicant has listed 45 claims on first page of application form. But specifications disclose only 35 claims. Clarification is requested.

### ***Election/Restriction***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-33 and 35 drawn to molecular circuits comprising nucleic acid molecules classified in class 536, subclass 24.1.
- II. Claim 34 drawn to a method of treating a subject by administering a pharmaceutical composition comprising an acceptable carrier and an expression vector to stimulate expression of gene of interest by applying heat treatment to the area of the subject in need of the protein, classified in class 514, subclass 44.

3. The inventions are distinct, each from the other because of the following reasons:

Invention I drawn to molecular circuits comprising isolated nucleic acid molecules and Invention II drawn to a method of use of the molecular circuit in a subject

Art Unit: 1645

and stimulate gene expression by stress or heat application to produce the protein of interest in the subject in need of the protein, are distinct each from the other, since they are drawn to a product and a method of in-vivo treatment.

4. Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)).

In the instant case the product as claimed can be used in a materially different process, such as in methods of gene therapy, as a therapeutic vector or as a nucleic acid probe.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their separate classification or divergent subject matter, restriction for examination purposes as indicated is proper.

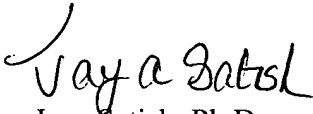
6. A telephone call was made to Mr Richard Sharkey on 11/19/99 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Art Unit: 1645

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jaya Satish at (703) 306 9047. The examiner can normally be reached, Monday through Friday from 9.00 AM to 4.00 PM. If attempts to reach the examiner by telephone are unsuccessful, a supervisory examiner, Anthony Caputa can be reached at (703) 305 -3995.

Any inquiry of a general nature should be directed to the Group receptionist at (703) 308-1235. Papers relating to this application may be faxed to Technology Center 1600 at (703) 308-4426. Any documents submitted by fax transmission will be considered an official communication unless the cover sheet clearly indicates that it is an informal communication.

  
Jaya Satish, Ph.D.

Dated : 11/19/99

  
**ALBERT NAVARRO**  
**UNIT EXAMINER**